

which is provided with a coating of an elastomer film at least on sides facing outward in at least one sealing area and which has an edge area, said edge area formed by at least one of an outer contour of the cylinder head, a cylinder bore or a water or oil passage in the cylinder head, said edge area adjacent to at least one peripheral self-contained cavity (2), wherein the cavity (2) is filled completely with a hydraulic medium (6);

wherein the hydraulic medium is liquid at least under operating conditions; and wherein the hydraulic medium is formed by a solder.

30. (Amended) The flat gasket for a reciprocating engine or a driven machine according to Claim 17, wherein the hydraulic medium comprises a polymer material that is plastically or elastically deformable at least under operating conditions.

## REMARKS

### I. Introduction

Claims 17 to 32 are currently pending in this application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicant notes with appreciation the acknowledgment of the claim for foreign priority and the indication that all of the certified copies of the priority documents have been received.

The cover sheet of the Office Action indicates that the Examiner has considered the previously filed Information Disclosure Statement, PTO-1449 paper and cited references. However, the Office Action did not include the actual signed off and initialed form PTO-1449. Accordingly, Applicant respectfully requests that the Examiner resend a copy of the signed off and initialed previously submitted form PTO-1449.

### II. Objection to the Specification

The Office Action objected to a claim reference in the Specification. Applicant has canceled the paragraph containing the objected to claim reference. Accordingly, withdrawal of the objection to the Specification is respectfully requested.

### **III. Rejection of Claims 17 to 32 Under 35 U.S.C. § 112**

Claims 17 to 32 were rejected under 35 U.S.C. § 112, second paragraph, as indefinite for allegedly failing to particularly point out and distinctly claim the subject matter of the invention. Claims 17 to 31 have been amended as per the suggestions in the Office Action. Claim 32 depends on amended claim 17. Applicant submits that claims 17 to 32, as amended, overcome the 35 U.S.C. § 112 rejection. Accordingly, withdrawal of the 35 U.S.C. § 112 rejection and allowance of claims 17 to 32 is respectfully requested.

### **IV. Rejection of Claims 17 and 18 Under 35 U.S.C. § 102 (b)**

Claims 17 and 18 were rejected under 35 U.S.C. § 102 (b) as anticipated by U.S. Patent No. 5,951,021 (“Ueta”). Applicant respectfully submits that Ueta does not anticipate the claims 17 and 18 for the following reasons.

Claim 17, from which claim 18 depends, relates to a flat gasket for a reciprocating engine or a driven machine having a cylinder. Claim 17, as amended, recites that the gasket comprises at least one metal sheet 0.05 to 0.5 mm thick having an edge area and coating of an elastomer film at least on sides facing outward in at least one sealing area. Claim 17 further recites that the edge area is formed by at least one of an outer contour of the cylinder head, a cylinder bore or a water or oil passage in the cylinder head. Claim 17 further recites that the edge area is adjacent to at least one peripheral hydraulic medium-filled **self-contained cavity**.

Ueta purportedly relates to a metallic gasket. Abstract. Ueta states that the gasket comprises base plate 11 which is folded back over a soft member 17 to form a folded portion 21. See col. 13, lines 49 to 53. The folded portion 21 of Ueta is not a **self-contained cavity**, as recited in amended claim 17. Accordingly, liquid hydraulic medium would leak out of the folded portion 21. The Office Action alleges that metal sheet 11 is flanged back onto itself in an edge area forming a cavity and is joined to itself adjacent the cavity. The base plate 11 in Ueta may be folded back over itself but it is not joined to itself, as the Office Action alleges, and does not form a self-contained cavity, as recited in amended claim 17. Therefore, Ueta does not disclose, or even suggest, all of the limitations of amended claim 17.

Notwithstanding the above, claim 17 has been amended to recite that the cavity is enclosed by at least one bead of the metal sheet and a second metal sheet (4)

bridging the bead, which are permanently jointed together adjacent to the bead. Nowhere does Ueta teach, or even suggest, a cavity enclosed by at least one bead of the metal sheet and a second metal sheet bridging the bead, wherein the metal sheet and second metal sheet are jointed together adjacent to the bead, as recited in amended claim 17. Therefore, Ueta does not disclose, or even suggest, all of the limitations of amended claim 17.

To anticipate a claim, each and every element as set forth in the claim must be found in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of Calif., 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). That is, the prior art must describe the elements arranged as required by the claims. In re Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). As more fully set forth above, it is respectfully submitted that Ueta does not disclose, or even suggest, a flat gasket including a self-contained cavity or a cavity enclosed by at least one bead of the metal sheet and a second metal sheet bridging the bead, wherein the metal sheet and second metal sheet are jointed together adjacent to the bead, as recited in amended claim 17. Accordingly, Ueta does not anticipate amended claim 17.

Additionally, to reject a claim under 35 U.S.C. § 102, the Examiner must demonstrate that each and every claim limitation is contained in a single prior art reference. See, Scripps Clinic & Research Foundation v. Genentech, Inc., 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991). Still further, not only must each of the claim limitations be identically disclosed, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the inventions of the rejected claims, as discussed above. See, Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986). In particular, it is respectfully submitted that, at least for the reasons discussed above, the reference relied upon would not enable a person having ordinary skill in the art to practice the inventions of the rejected claims, as discussed above. Also, to the extent that the Examiner is relying on the doctrine of inherency, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flows from the teachings of the applied art.” See M.P.E.P. § 2112;

emphasis in original; and see, Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Accordingly, the anticipation rejection as to the rejected claims must necessarily fail for the foregoing reasons.

As for claim 18, which has been rewritten in independent form, it is respectfully submitted that Ueta does not anticipate this claim for at least the reason that Ueta does not disclose, or even suggest, a **self-contained cavity** as recited by claim 18. Therefore, withdrawal of the 35 U.S.C. § 102 (b) rejection and allowance of claim 18 is respectfully requested.

In summary, it is respectfully submitted that Ueta does not anticipate amended claims 17 and 18. Accordingly, withdrawal of the 35 U.S.C. § 102 (b) rejection and allowance of claims 17 and 18 is respectfully requested.

#### **V. Rejection of Claims 17 to 20, 28 and 30 to 32 Under 35 U.S.C. § 103 (a)**

Claims 17 to 20, 28 and 30 to 32 were rejected as being obvious over U.S. Patent No. 5,582,415 ("Yoshida et al.") in view of U.S. Patent No. 4,140,323 ("Jacobs"). Claim 19 has been canceled thus rendering the rejection of this claim moot. Applicant respectfully submits that claims 17, 18, 20, 28 and 30 to 32 are patentable over the combination of Yoshida et al. and Jacobs for the following reasons.

Yoshida et al. purportedly relate to a metal gasket 10. Abstract. Yoshida et al. state that metal gasket 10 comprises a beaded plate 45, including bead 16, and a stiffening plate 46 which is stated to wrap around a periphery of the opening of the beaded plate 45. See col. 8, lines 3 to 5. Metal gasket 10 is stated to be held between cylinder block 1 and cylinder head 4. See col. 5, lines 33 to 35.

Jacobs purportedly relates to an embossed gasket. Abstract. Jacobs recites a gasket having a filler filled cavity. Abstract.

The Office Action admits that Yoshida et al. do not disclose a cavity that is completely filled with a hydraulic medium. The Office Action alleges, however, that given Jacobs alleged teaching of a gasket having a hydraulic medium filled cavity it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Yoshida et al., as allegedly taught by Jacob, in order to prevent the bead from flattening out and losing sealing integrity. Applicant respectfully disagrees.

The Office Action alleges that it would have been obvious to completely fill the self-contained cavity, as recited in claim 17, however, U.S. Patent No. 6,145,847 ("Maeda et al."), also cited by the Office Action, teaches away from completely filling the cavity. Maeda et al. purportedly relates to a metal laminate gasket for use in an internal combustion engine. Abstract. The gasket is stated to include at least two metal plates, each stated to have at least one hole to be sealed and a plurality of bolt holes. Abstract. The first metal plate is stated to have an annular bead portion surrounding the at least one hole. Abstract. A rigid synthetic resin layer is stated to fill a part of a recess of a bead portion of a first metal plate. Abstract. The resin layer is stated to enhance sealing. Abstract. The height of the resin layer is stated to be adjusted in accordance with the distance from the bolt hole 4, and thus not completely fill the recess, in order to uniform sealing pressure around the periphery of the combustion chamber hole 3. Accordingly, Maeda et al. in effect teach away from completely filling an annular bead portion of a gasket with a resin layer. Given the existence of art teaching away from completely filling an annular bead portion with a resin layer, Applicant submits that it would not have been obvious to completely fill in the self-contained cavity with a hydraulic medium, as recited in claim 17.

Notwithstanding the above, claim 17 has been amended to recite that the cavity is enclosed by at least one bead of the metal sheet and a second metal sheet (4) bridging the bead, which are permanently jointed together adjacent to the bead. Nowhere do Yoshida et al. or Jacobs teach, or even suggest, a cavity enclosed by at least one bead of the metal sheet and a second metal sheet bridging the bead, wherein the metal sheet and second metal sheet are permanently jointed together adjacent to the bead, as recited in amended claim 17.

The Office Action alleges that Yoshida et al. disclose the metal sheet and second metal sheet being permanently joined together and refers to col. 5, lines 6 to 10. However, this reference only states that a coating layer 30 is formed on an upper and lower side of the bead 16. Even if this coating assured a fluid-tight seal, as the Office Action alleges, nowhere does Yoshida et al. state that beaded plate 45, including bead 16, is permanently joined together with stiffening plate 46 adjacent bead 16. Accordingly, Yoshida et al. do not disclose all of the limitations of amended claim 17.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). As stated above, Yoshida et al. fail to disclose, or even suggest, each and every feature of amended claim 17. Specifically, Yoshida et al. do not teach, or even suggest, a cavity enclosed by at least one bead of the metal sheet and a second metal sheet bridging the bead, wherein the metal sheet and second metal sheet are permanently jointed together adjacent to the bead, as recited in amended claim 17. Nor does Jacobs cure the deficiencies of Yoshida et al. It is therefore respectfully submitted that the combination of Yoshida et al. and Jacobs does not render obvious amended claim 17.

Moreover, it is respectfully submitted that the cases of *In re Fine, supra*, and *In re Jones*, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), make plain that the Office Action's generalized assertions that it would have been obvious to modify or combine the reference do not properly support a § 103 rejection. It is respectfully submitted that those cases make plain that the Office Action reflects a subjective "obvious to try" standard, and therefore does not reflect the proper evidence to support an obviousness rejection based on the reference relied upon. In particular, the Court in the case of *In re Fine* stated that:

The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. This it has not done. . . .

**Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.**

*In re Fine*, 5 U.S.P.Q.2d at 1598 to 1600 (citations omitted; italics in original; emphasis added). Likewise, the Court in the case of *In re Jones* stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

**Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].**

*In re Jones*, 21 U.S.P.Q.2d at 1943, 1944 (citations omitted; italics in original).

That is exactly the case here since it is believed and respectfully submitted that the present Office Action offers no evidence whatsoever, but only conclusory hindsight, reconstruction and speculation, which these cases have indicated does not constitute evidence that will support a proper obviousness finding. Unsupported assertions are not evidence as to why a person having ordinary skill in the art would be motivated to modify or combine references to provide the claimed subject matter of the claims to address the problems met thereby. Accordingly, the Office must provide proper evidence of a motivation for modifying or combining the reference to provide the claimed subject matter.

More recently, the Federal Circuit in the case of *In re Kotzab* has made plain that even if a claim concerns a "technologically simple concept" -- which is not the case here -- there still must be some finding as to the "specific understanding or principle within the knowledge of a skilled artisan" that would motivate a person having no knowledge of the claimed subject matter to "make the combination in the manner claimed," stating that:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed

to multiple sensors controlling multiple valves, is a technologically simple concept. With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab's invention to make the combination in the manner claimed. In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper prima facie case of obviousness in rejecting [the] claims . . . under 35 U.S.C. Section 103(a) over Evans.

*In re Kotzab*, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000) (emphasis added). Again, it is believed that there have been no such findings.

Accordingly, there is no evidence that the reference relied upon, whether taken alone, combined or modified, would provide the features and benefits of amended claim 17 herein. It is therefore respectfully submitted that amended claim 17 is allowable for these reasons.

As for claims 20, 28 and 30 to 32, which ultimately depend on amended claim 17 and therefore include all of the limitations of amended claim 17, Applicant submits that these claims are patentable for at least the same reasons provided above in support of amended claim 17. *In re Fine, supra* (any dependent claim depending from a non-obvious independent claim is non-obvious). Accordingly, withdrawal of the 35 U.S.C. § 103(a) rejection and allowance of claims 17, 20, 28 and 30 to 32 is respectfully requested.

As for amended claim 18, Applicant reasserts the arguments made above in support of the patentability of amended claim 17, relating to the recitation of a cavity completely filled with hydraulic medium, and submits the following additional reasons in support of patentability. Claim 18 has been rewritten in independent form. Claim 18 relates to a flat gasket for a reciprocating engine or a driven machine having a cylinder head. Claim 18 recites that the flat gasket includes at least one metal sheet 0.05 to 0.5 mm thick having an edge area. Claim 18 further recites that the edge area is adjacent to at least one peripheral self-contained cavity and that the cavity is filled completely with a hydraulic medium (6). Claim 18 further recites that the metal sheet (1) is flanged back onto itself in the edge area, forming the cavity (2), and is

joined to itself adjacent to the cavity. As amended, claim 18 further recites that the metal sheet has at least on sides facing outward from the cavity an elastomer film.

Yoshida et al. state that beaded plate 11 has a coating layer 30 which covers beads 16 to 20 and their vicinity. Coating layer is specifically stated and shown (see Figures 5, 14 and 17, for example) not to be on other parts, including flanged stopper 22, stated not necessary for sealing. See col. 4, line 64 to col. 5, line 2 as well as col. 5, lines 57 to 58. Accordingly, Yoshida et al. do not disclose, or even suggest, a metal sheet flanged back onto itself in an edge area, forming a cavity and joined to itself adjacent to the cavity, wherein the metal sheet has at least on sides facing outward from the cavity an elastomer film, as recited in amended claim 18. Nor does Jacobs cure this deficiency of Yoshida et al. Accordingly, claim 18 is patentable over the combination of Yoshida et al. and Jacobs.

The Office Action alleges that Yoshida et al. in Figure 14 disclose a metal sheet flanged back onto itself and joined to itself in its edge area forming a cavity. See Office Action at p. 5. The Office Action further alleges that a cavity is formed by at least one bead 16. However, claim 18 recites that the cavity be formed by the metal sheet flanged back onto itself. The flange portion 115 in Yoshida et al. does not form bead 16, which the Office Action alleges forms the cavity. Nor is the metal sheet of Yoshida et al. joined to itself, as recited in claim 18.

In summary, Applicant submits that claims 17, 18, 20, 28 and 30 to 32 are patentable over the combination of Yoshida et al. and Jacobs. Therefore, withdrawal fo the 35 U.S.C. § 103(a) rejection and allowance of these claims is respectfully requested.

#### **VI. Rejection of Claims 21 to 23 Under 35 U.S.C. § 103 (a)**

Claims 21 to 23 were rejected as being obvious over Yoshida et al. in view of Jacobs, as applied to claim 19, and further in view of Maeda et al. Applicant respectfully submits that claims 21 to 23 are patentable over the combination of Yoshida et al., Jacobs and Maeda et al. for the following reasons.

Applicant submits that claims 21 to 23, which ultimately depend on claim 17, are patentable over the combination of Yoshida et al., Jacobs and Maeda et al. for at least the reasons provided above in support of the patentability of claim 17. Neither Jacobs or Maeda et al. cure the above noted deficiencies of Yoshida et al.

Therefore, withdrawal of the 35 U.S.C. § 103(a) rejection and allowance of claims 21 to 23 is respectfully requested.

**VII. Rejection of Claim 24 Under 35 U.S.C. § 103 (a)**

Claim 24 was rejected as being obvious over Yoshida et al. in view of Jacobs, as applied to claim 19, and further in view of U.S. Patent No. 4,428,593 ("Pearlstein"). Applicant respectfully submits that claim 24, which depends on claim 17, is patentable over the combination of Yoshida et al., Jacobs and Pearlstein for at least the reasons provided above in support of the patentability of claim 17. Neither Jacobs or Pearlstein cure the above noted deficiencies of Yoshida et al. Therefore, withdrawal of the 35 U.S.C. § 103(a) rejection and allowance of claim 24 is respectfully requested.

**VIII. Rejection of Claims 25 to 27 Under 35 U.S.C. § 103 (a)**

Claims 25 to 27 were rejected as being obvious over Yoshida et al. in view of Jacobs, as applied to claim 19, and further in view of U.S. Patent No. 6,135,459 ("Hiramatsu et al."). Applicant respectfully submits that claims 25 to 27 are patentable over the combination of Yoshida et al., Jacobs and Hiramatsu et al. for at least the reasons provided above in support of the patentability of claim 17 as well as for the following additional reasons.

Amended claim 25, from which claims 26 and 27 depend, depends on claim 17 and recites a third metal sheet (8) arranged between the metal sheet (1) and the second metal sheet (4). Claim 25 further recites that the third metal sheet is included in a connection between the first and second metal sheets. Claim 25 further recites that the metal sheet (1) and the third metal sheet (8) define a first portion of the cavity (2), and that the third metal sheet (8) and the second metal sheet (4) define a second portion of the cavity (2). Claim 25 further recites that the first portion and second portion of the cavity (2) on both sides of the third metal sheet are in hydraulic connection (16) with one another.

The Office Action references Figure 2 and alleges that Hiramatsu et al. teaches cavities on both sides of a third metal sheet that are in hydraulic communication with one another, as recited in claim 25. See Office Action at p. 7. Applicant respectfully submits that Hiramatsu et al., do not disclose, or even suggest, a first portion and a second portion of a cavity on both sides of a third metal sheet that

are in hydraulic connection with one another, as recited in amended claim 25. Nowhere does Hiramatsu et al. state that stopper plate 4 is configured to allow for hydraulic communication between areas defined above and below it.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). As indicated above, to establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). As stated above, Yoshida et al. fail to disclose, or even suggest, each and every feature of amended claim 17. Specifically, Yoshida et al. do not teach, or even suggest, a cavity enclosed by at least one bead of the metal sheet and a second metal sheet bridging the bead, wherein the metal sheet and second metal sheet are permanently jointed together adjacent to the bead, as recited in amended claim 17. Nor do Jacobs or Hiramatsu et al. cure the deficiencies of Yoshida et al. Specifically, neither Jacobs or Hiramatsu et al. disclose a first portion and a second portion of a cavity on both sides of a third metal sheet that are in hydraulic connection with one another, as recited in amended claim 25. It is therefore respectfully submitted that the combination of Yoshida et al., Jacobs and Hiramatsu et al. does not render obvious amended claim 25 , which depends from claim 17 and therefore include all of the limitations of claim 17. Therefore, withdrawal of the 35 U.S.C. § 103(a) rejection and allowance of amended claim 25 is respectfully requested.

As for claims 26 and 27, which depend from claim 25 and therefore include all of the limitations of claim 25, Applicant submits that these claims are allowable for at least the same reasons provided above in support of the patentability of claim 25. Therefore, withdrawal of the 35 U.S.C. § 103(a) rejection and allowance of amended claims 26 and 27 is respectfully requested.

**IX. Objection to Claim 29**

The Office objected to claim 29 as being dependent upon a rejected base claim but indicated that claim 29 would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims. Applicant has rewritten claim 29 in independent form including all the limitations of the base claim and any intervening claims. Claim 29 also includes the amendments made in response to the 35 U.S.C. § 112 rejection. No new matter has been added. Accordingly, withdrawal of the objection and allowance of claim 29 is respectfully requested.

**X. Conclusion**

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Attached hereto is a marked-up version of the changes made to the Specification and the claims by the current Amendment. The attached page is captioned "**Version with Markings to Show Changes Made.**"

Respectfully submitted,

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**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

**IN THE SPECIFICATION:**

On page 3, the paragraph starting on line 3, has been canceled.

**IN THE CLAIMS:**

Claim 19 has been canceled.

Claims 17, 18 and 20 to 30 have been amended, without prejudice, as follows:

17. (Amended) A flat gasket for a reciprocating engine or a driven machine having a cylinder head, comprising: at least one metal sheet 0.05 to 0.5 mm thick which is provided with a coating of an elastomer film at least on sides facing outward in at least one sealing area and which has an edge area, said edge area formed by [the] at least one of an outer contour of the cylinder head, [or at least one] a cylinder bore or a water or oil passage in the cylinder head, said edge area adjacent to at least one peripheral self-contained cavity (2), wherein the cavity (2) is filled completely with a hydraulic medium (6); and

wherein the cavity (2) is enclosed by at least one bead (3) of the metal sheet (1) and a second metal sheet (4) bridging the bead, which are permanently jointed together adjacent to the bead.

18. (Amended) [The] A flat gasket for a reciprocating engine or a driven machine [according to Claim 17,] having a cylinder head, comprising: at least one metal sheet 0.05 to 0.5 mm thick which is provided with a coating of an elastomer film and which has an edge area, said edge area formed by at least one of an outer contour of the cylinder head, a cylinder bore or a water or oil passage in the cylinder head, said edge area adjacent to at least one peripheral self-contained cavity (2), wherein the cavity (2) is filled completely with a hydraulic medium (6);

wherein the metal sheet (1) is flanged back onto itself in the edge area, forming the cavity (2), and is joined to itself adjacent to the cavity; and

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wherein the metal sheet has at least on sides facing outward from the cavity an elastomer film.

20. (Amended) The flat gasket for a reciprocating engine or a driven machine according to Claim [19] 17, wherein the metal sheet (1) and the second metal sheet (4) are joined in a fluid-tight manner.

21. (Amended) The flat gasket for a reciprocating engine or a driven machine according to Claim [19] 17, wherein in the area of the bead (3) of the metal sheet (1) the second metal sheet (4) has a second bead (5).

22. (Amended) The flat gasket for a reciprocating engine or a driven machine according to Claim 21, wherein the second bead (5) of the second metal sheet (4) has a different design from that of the first bead (3) of the metal sheet (1).

23. (Amended) The flat gasket for a reciprocating engine or a driven machine according to Claim 21, wherein the second bead (5) of the second metal sheet (4) has a profile with a smaller cross section than the first bead (3).

24. (Amended) The flat gasket for a reciprocating engine or a driven machine according to Claim [19] 17, wherein the second metal sheet (4) has a second bead (5) in mirror image to the bead (3) of the [first] metal sheet (1).

25. (Amended) The flat gasket for a reciprocating engine or a driven machine according to Claim [19] 17, wherein a third metal sheet (8) is arranged between the [first] metal sheet (1) and the second metal sheet (4); and the third metal sheet is included in [the] a connection between the first and second metal sheets; the metal sheet (1) and the third metal sheet (8) defining a first portion of the cavity (2), the third metal sheet (8) and the second metal sheet (4) defining a second portion of the cavity

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(2), [and the cavities (2) on] the first portion and second portion of the cavity (2) on both sides of the third metal sheet are in hydraulic connection (16) with one another.

26. (Amended) The flat gasket for a reciprocating engine or a driven machine according to Claim 25, wherein the third metal sheet (8) in the area of the [first and second beads] first bead (3) of the metal sheet (1) and the second bead (5) of the second metal sheet (4) has a third bead (15) having a differently shaped profile.

27. (Amended) The flat gasket for a reciprocating engine or a driven machine according to Claim 26, wherein the [first, second or third beads] first bead (3) of the first metal sheet (1), the second bead (5) of the second metal sheet (4) or the third bead (15) of the third metal sheet (8) are subdivided into at least two partial beads (12).

28. (Amended) The flat gasket for a reciprocating engine or a driven machine according to Claim 17, wherein [each cavity (2) is filled with a substance that] the hydraulic medium is liquid at least under operating conditions.

29. (Amended) [The] A flat gasket for a reciprocating engine or a driven machine [according to Claim 28,] having a cylinder head, comprising: at least one metal sheet 0.05 to 0.5 mm thick which is provided with a coating of an elastomer film at least on sides facing outward in at least one sealing area and which has an edge area, said edge area formed by at least one of an outer contour of the cylinder head, a cylinder bore or a water or oil passage in the cylinder head, said edge area adjacent to at least one peripheral self-contained cavity (2), wherein the cavity (2) is filled completely with a hydraulic medium (6);

wherein the hydraulic medium is liquid at least under operating conditions; and wherein the [substance] hydraulic medium is formed by a solder.

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30. (Amended) The flat gasket for a reciprocating engine or a driven machine according to Claim 17, wherein the [cavity is filled with] hydraulic medium comprises a polymer material that is plastically or elastically deformable at least under operating conditions.